



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,096	02/05/2004	Todd R. Smith	4804/13	3293

7590 07/10/2009  
Frommer Lawrence & Haug LLP  
745 Fifth Avenue  
New York, NY 10151

EXAMINER
----------

NGUYEN, THUY-VI THI

ART UNIT	PAPER NUMBER
----------	--------------

3689

MAIL DATE	DELIVERY MODE
-----------	---------------

07/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/773,096

**Applicant(s)**

SMITH, TODD R.

**Examiner**

THUY-VI NGUYEN

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to method for facilitating importing merchandise into a country; classified in class 705, subclass 27.
  - II. Claims 6-11, 18-23 drawn to a method and system for creating a compliance audit trail for importing merchandise into a country; classified in class 705, subclass 01.
  - III. Claims 12, drawn to method for obtaining subscribers to a merchandise classification service, classified in class 705, subclass 01.
  - IV. Claims 13 -14, drawn to a method for providing a merchandise classification system which deals with different access levels to a merchandise classification system, classified in class 705, subclass 27.
  - V. Claim 32, drawn to a method for providing a merchandise classification system which deals with the searchable directory of advisors involved in merchandise classification and allocating the advisor's subscription fee to use the merchandise classification, classified in class 705, sub class 01.
  - VI. Claims 15-17; 24-31, 33-40, drawn a system, method for providing merchandise classification for customs compliance which deals with inputting, searching and receiving, selecting a results regarding to the item of merchandise; class 705, subclass 27.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions in **Groups I and II** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group I is directed to method for facilitating importing merchandise into a country, while invention of group II is directed to method and system for creating a compliance audit trail for importing merchandise into a country comprising a comparison the inputted data to the database of customs-related information to obtain classification of at least one item merchandise.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group I, is not necessarily required for Group II due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

3. Inventions in **Groups I and III** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group I is directed to method for facilitating importing merchandise into a country, while invention of group III is directed to method for obtaining subscribers to a merchandise classification service comprising a requirement of at least one party to subscribe to a merchandise classification service to access the inputted information.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group I, is not necessarily required for Group III due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

4. Inventions in **Groups I and IV** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group I is directed to method for facilitating importing merchandise into a country, while invention of group IV is directed to a method for providing a merchandise classification system which deals with different access levels to a merchandise classification system.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group I, is not necessarily required for Group IV due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

5. Inventions in **Groups I and V** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group I is directed to method for facilitating importing merchandise into a country, while invention of group IV is directed to a method for providing a

merchandise classification system which deals with the searchable directory of advisors involved in merchandise classification and allocating the advisor's subscription fee to use the merchandise classification

Because these inventions are independent or distinct for the reasons given above, because the search required for Group I, is not necessarily required for Group V due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

**6.** Inventions in **Groups I and VI** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group I is directed to method for facilitating importing merchandise into a country, while invention of group VI is directed a system, method for providing merchandise classification for customs compliance which deals with inputting, searching and receiving, selecting a results regarding to the item of merchandise

Because these inventions are independent or distinct for the reasons given above, because the search required for Group I, is not necessarily required for Group VI due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

7. Inventions in **Groups II and III** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group II is directed to method and system for creating a compliance audit trail for importing merchandise into a country, while invention of group III is directed to method for obtaining subscribers to a merchandise classification service.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group II, is not necessarily required for Group III due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

8. Inventions in **Groups II and IV** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group II is directed to method and system for creating a compliance audit trail for importing merchandise into a country, while invention of group IV is directed a method for providing a merchandise classification system which deals with different access levels to a merchandise classification system.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group II, is not necessarily required for Group

IV due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

9. Inventions in **Groups II and V** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group II is directed to method and system for creating a compliance audit trail for importing merchandise into a country, while invention of group V is directed a method for providing a merchandise classification system which deals with the searchable directory of advisors involved in merchandise classification and allocating the advisor's subscription fee to use the merchandise classification.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group II, is not necessarily required for Group V due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

10. Inventions in **Groups II and VI** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group II is directed to method and system for creating a compliance audit trail for importing merchandise into a country, while invention of group VI is directed a system, method for providing merchandise classification for customs



compliance which deals with inputting, searching and receiving, selecting a results regarding to the item of merchandise.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group II, is not necessarily required for Group VI due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

**11.** Inventions in **Groups III and IV** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group III is directed to method for obtaining subscribers to a merchandise classification service comprising a requirement of at least one party to subscribe to a merchandise classification service to access the inputted information, while invention of group IV is directed a method for providing a merchandise classification system which deals with different access levels to a merchandise classification system.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group III, is not necessarily required for Groups IV due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

**12.** Inventions in **Groups III and V** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group III is directed to method for obtaining subscribers to a merchandise classification service comprising a requirement of at least one party to subscribe to a merchandise classification service to access the inputted information, while invention of group V is directed a method for providing a merchandise classification system which deals with the searchable directory of advisors involved in merchandise classification and allocating the advisor's subscription fee to use the merchandise classification.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group III, is not necessarily required for Group V due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

**13.** Inventions in **Groups III and VI** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group III is directed to method for obtaining subscribers to a merchandise classification service comprising a requirement of at least one party to subscribe to a merchandise classification service to access the inputted information, while invention of group VI is directed a system, method for providing merchandise

classification for customs compliance which deals with inputting, searching and receiving, selecting a results regarding to the item of merchandise.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group III, is not necessarily required for Group VI due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

**14.** Inventions in **Groups IV and V** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group IV is directed a method for providing a merchandise classification system which deals with different access levels to a merchandise classification system., while invention of group V is directed a method for providing a merchandise classification system which deals with the searchable directory of advisors involved in merchandise classification and allocating the advisor's subscription fee to use the merchandise classification.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group IV, is not necessarily required for Group V due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

**15.** Inventions in **Groups IV and VI** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group IV is directed a method for providing a merchandise classification system which deals with different access levels to a merchandise classification system., while invention of group VI is directed a system, method for providing merchandise classification for customs compliance which deals with inputting, searching and receiving, selecting a results regarding to the item of merchandise.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group IV, is not necessarily required for Group VI due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

**16.** Inventions in **Groups V and VI** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group V is directed a method for providing a merchandise classification system which deals with the searchable directory of advisors involved in merchandise classification and allocating the advisor's subscription fee to use the merchandise classification, while invention of group VI is directed a system, method for providing merchandise classification for customs compliance which deals with inputting, searching and receiving, selecting a results regarding to the item of merchandise.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group V, is not necessarily required for Group VI due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

**Note:** In the instant case, the different inventions have different modes of operation and thus producing different effects and are not capable of use together to achieve their respective scopes even though there may be one or two common steps. Also, the limitations in the preamble is considered as "capable of" carrying out the scope of the claimed invention and the method steps are considered essential to carry out the invention.

17. Applicant is advised that the reply to this requirement to be complete must include an election of the invention, either group I or II or III or IV or V or VI, to be examined even though the requirement be traversed (37 CFR 1.143).

### ***Conclusions***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone

Art Unit: 3689

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
7/7/09